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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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08/120,303      09/13/93      JACOBS

P      JJM

EXAMINER

IM52/0718

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SNAY, J

ART UNIT

PAPER NUMBER

32

1743

DATE MAILED:

07/18/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

08/120,303

Applicant(s)

JACOBS ET AL.

Examiner

Jeffrey R. Snay

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1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2000.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 11-19, 21 and 22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 12-16, 21 and 22 is/are allowed.
- 6) ☒ Claim(s) 11 and 17-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120.

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 11 and 17-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 11 recites a "means for connecting said opening of said vessel to said lumen said vessel being closed to the ambient atmosphere except through such opening". Claim 17, as now amended, recites a "means for connecting said opening of said cartridge to said lumen said cartridge being closed to the ambient atmosphere except through such opening". As articulated by the Board of Appeals in the decision mailed 04/28/00, the present specification provides specific examples for a "means for connecting said vessel to the end of said lumen" but provides no corresponding structure for a "means for connecting said opening of said vessel to said lumen". See page 8 of the Board decision. Analogously, the specification provides no corresponding structure for the newly claimed "a "means for connecting said opening of said cartridge to said lumen said cartridge being closed to the ambient atmosphere except through such opening" as recited in claim 17. In view of the lack of a disclosed corresponding structure for connecting the opening of the vessel (claim 11), nor of the cartridge (claim 17), neither an actual means nor means that are equivalent to the actual means can be determined. Therefore, claims 11 and 17-19 are of indeterminate scope and rejected under 35 U.S.C. 112, second paragraph, as being indefinite.

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Claim 17 is further indefinite under 35 U.S.C. 112, second paragraph, for the following reasons. The claim recites as an element "a vessel including a cartridge". Thus the cartridge is an element of the vessel. This is not commensurate with the specification which teaches, with respect to Figure 2A, that the vessel is attached to a cartridge, thus forming separate elements connected together. See for example page 12 of the specification teaching that "Figure 2A illustrates a variation in the design of the device of Fig. 2 which utilizes the same basic vessel and means for attachment to a tubular device. In the device shown in Fig. 2A, end 45 of the vessel opposite the open end is provided with aperture 46 for attaching a disposable cartridge 47 containing a supply of antimicrobial on a substrate ...". Therefore, the specification fails to provide an adequate description by which one of ordinary skill in the art could clearly discern applicant's newly amended claim language of "a vessel including a cartridge". Furthermore, in lines 4-5 of claim 17, the language "having an opening therein" cannot be determined as to whether the opening is present in the vessel or the cartridge. Furthermore, the recited language that the means for connecting includes an opening for releasably attaching the cartridge "to form said vessel" is general vague and indefinite for the reasons stated above. Specifically, the specification clearly teaches the "vessel" and the "cartridge" as being separate and attachable elements, rather than a single "vessel".

3. Applicant is advised that, in the event the claims were amended such that the means plus function language were changed to that previously recited in now cancelled

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claim 20, which was deemed by the Board as having corresponding structure disclosed in the specification, the previous rejection based on the disclosure of Wyka would be reinstated.

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Each of Keith and Andersen et al disclose vessels containing a known amount of antimicrobial solution, the vessels being connected to a lumen.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey R. Snay whose telephone number is (703) 308-4032. The examiner can normally be reached on Mon-Fri.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on (703) 308-4037. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7718 for regular communications and (703) 308-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-5665.



Jeffrey R. Snay  
Primary Examiner  
Art Unit 1743

jrs  
July 13, 2001